



10 MAY 2005
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In re Application of
Martin, et al.
Application No.: 10/506,721
PCT No.: PCT/US03/06793
Int. Filing Date: 04 March 2003
Priority Date: 07 March 2002
Attorney's Docket No.: 980049.402USPC
For: QUINAZOLINONE MODULATORS OF
NUCLEAR RECEPTORS

RESPONSE

This is in response to applicant's request to refund \$11,215, filed 22 March 2005. Applicant urges that the extra claim fees were charged in error.

BACKGROUND

On 04 March 2003, applicants filed international application PCT/US03/06793 which claimed priority to a United States provisional application which was filed 07 March 2002. A copy of the international application was communicated from the International Bureau on 18 September 2003. Accordingly, the thirty-month period for paying the basic national fee in the national stage in the United States expires at midnight on 07 September 2004.

On 07 September 2004, applicant filed a transmittal letter including, *inter alia*, a check for \$525 which included the basic national fee of \$460 and the \$65 fee for providing the oath/declaration after 30 months from the earliest priority date, as well as authorization to charge applicant's deposit account #19-1090 any additional fees that may be required. These papers were assigned U.S. application number 10/506,721.

On 19 January 2005, the United States Patent and Trademark Office charged applicant's deposit account an additional \$11,070 and \$145 for additional claim fees.

On 22 March 2005, applicant filed the current request for refund indicating that the fees charged on 19 January 2005 were charged in error.

DISCUSSION

As indicated above, the transmittal letter (Form PTO-1390) included a general authorization to charge "any additional fees that may be required." Extra claims fees are required for claims presented in excess of 20. See MPEP 607. Contrary to Petitioner's assertion, the general deposit account authorization provided in Form PTO-1390 was not limited to "fees required in order to obtain a filing date for the application."¹

MPEP 1893.01 states, in part:

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(b)-(c) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(d). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608.

A review of the application finds that on filing of the application, applicant included several multiple dependent claims. Applicant did not include a preliminary amendment reducing the number of claims. Therefore, applicant was charged the proper fees.

CONCLUSION

For the above reasons, the request for refund is **DISMISSED without prejudice.**

¹ Moreover, since the actual filing date of a US national stage application is its international filing date, (see 35 U.S.C. 363), a deposit account authorization limited to charging fees necessary to obtain a filing date would have no practical benefit.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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